IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William N. Youstra   Art Unit : 2157
Serial No. : 09/867,797   Examiner : Avi M. Gold
Filed   : May 31, 2001   Conf. No. : 6602
Title   : AUTHENTICATION OF ELECTRONIC DATA

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005, New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of Examiners is requested because the rejections of record are not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-52 are pending, with claims 1, 19, 20, 25, 29, 33, 34, and 39 being independent. Claims 1, 19, 20, 25, 33, 34, and 39 have been rejected under 35 U.S.C. § 103 as being rendered obvious over U.S. Patent No. 6,393,465 ("Leeds") in view of U.S. Patent No. 6,766,352 to McBrearty et al. ("McBrearty").

Applicant respectfully disagrees with, and hereby asks the panel to review and reverse, these rejections.

Discussion

Independent claim 1 reads:

A method for transmitting electronic data, the method comprising:

receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient;

endorsing the electronic data based on attributes of the electronic data; and

modifying the electronic data with endorsement information so that presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages.

Claims 1, 19, 20, 25, 33, 34, and 39 have been rejected under 35 U.S.C. § 103 as being rendered obvious over U.S. Patent No. 6,393,465 ("Leeds") in view of U.S. Patent No. 6,766,352 to McBrearty et al. ("McBrearty").

Applicant requests withdrawal of this rejection because Leeds fails to describe or suggest "modifying the electronic data with endorsement information so that presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages," as recited by independent claim 1, and because one of ordinary skill in the art would not have been motivated to modify Leeds in the manner suggested in the final Office Action of August 24, 2006.

Leeds is directed to a spam filtering system. As noted in the abstract, Leeds uses a scoring system to determine whether incoming mail can be deleted. See Leeds at Fig. 6b (a rating is assigned a message and used to process the message); see also Leeds at col. 4, lines 55-60 (a score of 100 can be used to trigger automatic deletion of a message). It is important to note that the scoring system in Leeds performs analytical operations before the user perceives a message. Leeds does not describe how a message is presented to a user nor how presentation of a message is based on the message-processing operations that are performed. As such, Leeds does not describe or suggest "modifying the electronic data with endorsement information so that presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages," as recited by amended claim 1. Realizing this deficiency of Leeds, the Office Action relies on McBrearty to show "presentation of the electronic data that visually distinguishes

endorsed messages from nonendorsed messages," suggesting that it would have been obvious to modify Leeds with the teachings of McBrearty. See the final Office Action of Aug. 24, 2006 at page 3, lines 13-15. Applicant respectfully disagrees for the reasons discussed below.

McBrearty relates to techniques for displaying files to a user on a client system and identifying whether the file is a cached file or a newly downloaded file. See McBrearty at Abstract and col. 1, lines 16-20. McBrearty explains that the requested file may be displayed to the user in a graphical user interface along with an indicator that informs the user of whether the file is a cached file. See McBrearty at col. 2, line 65 to col. 3, lines 2.

A proposed modification of the prior art that renders it unsatisfactory for its intended purpose is not an obvious modification. See MPEP § 2143.01(V). As such, the modification of Leeds with McBrearty is not an obvious modification. Leeds' techniques provide "enhanced blocking of junk email." See Leeds at col. 2, lines 10-13. In particular, Leeds' techniques involve determining whether an email is a junk email (spam), and either filing or deleting emails deemed to be spam before the intended recipient perceives the spam email. See Leeds at col. 6, lines 25-34; Fig. 6b; col. 8, lines 4-9. Thus, Leeds' techniques prevent the intended recipient from perceiving emails that are deemed to be spam. This is contrary to McBrearty, which displays a user-requested file to the requesting user along with an indication of whether the file is a cached file. In other words, McBrearty displays both locally-cached and newly-downloaded files to the requesting user. In contrast, Leeds does not display emails deemed to be spam to the intended recipient. Indeed, as noted above, a purpose of Leeds is to block junk email before it can be perceived the intended recipient. Thus, there would have been no motivation to modify Leeds with the teachings of McBrearty.

The Advisory Action notes that Leeds and McBrearty are analogous art because "they are both centered on electronic data." See Advisory Action of Nov. 13, 2006 at page 2. Applicant respectfully disagrees because, regardless of whether Leeds and McBrearty are analogous art, there would have been no motivation to combine these references for the reasons discussed above. The Advisory Action also states that the motivation to combine Leeds and McBrearty is "generally available to one of ordinary skill in the art." See Advisory Action of Nov. 13, 2006.

However, the Applicant respectfully notes that the Advisory Action is making a broad assertion regarding the source of the motivation to combine without providing factual evidence.

Because it would not have been obvious to modify Leeds with the teachings of McBrearty, Applicant respectfully requests reversal of the rejection of claim 1, and claims 2-18 and 40-46, which depend from claim 1.
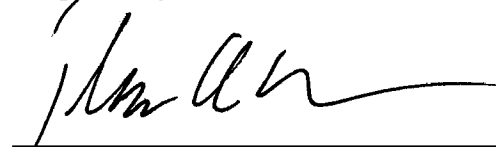
Claims 19-39 recite limitations that are similar to those discussed above for the purpose of the rejection raised with respect to claim 1. Accordingly, Applicant respectfully requests reversal of the rejection of independent claims 19, 20, 25, 29, 33, 34, and 39, along with claims 21-24, 26-28, 30-32, 35-38, and 47-52, which depend from these independent claims.

Furthermore, none of the other references used in making the obviousness rejection in the final Office Action of August 24, 2006 describe or suggest "modifying the electronic data with endorsement information so that presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages," as recited by independent claim 1. Accordingly, the rejections based on those references should also be reversed.

Please apply any charges or credits to Deposit Account 06-1050.

Respectfully submitted,

Date: 11/22/2006

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